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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,272	03/12/2004	Kil-soo Jung	1793.1226	5860

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STEIN, MCEWEN & BUI, LLP
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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2167

MAIL DATE	DELIVERY MODE
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08/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/798,272	JUNG ET AL.	
	Examiner	Art Unit	
	Cheryl Lewis	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/24/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the applicants' communication received on May 22, 2007.
2. Claims 1-40 are presented for examination. Applicants have amended claims 1, 9, 15, 23, and 29-31 in the amendment received on May 22, 2007.
3. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new grounds of rejection.

Information Disclosure Statement

4. The information disclosure statement filed April 24, 2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because foreign documents labeled AG-AJ of the Information Disclosure Statement contain an abstract of the foreign documents that is not presented in English. If it is the applicants' intention to rely on these documents as being important to the applicants' disclosure, then the Examiner kindly recommends that the applicants should submit an English translation of these foreign documents. Likewise, the Office Action prepared by Examiner Xiaoqing LI (A440) of the Chinese Patent Application is not relevant to the disclosure ("Other References" cited on the Information Disclosure Statement are relevant for published Non-Patent literature documents). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this

information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Remarks

5. In regards to the applicants' assertion that the Examiner's prior 101 rejection cited in the Office Action dated May 22, 2007 are not easily comprehensible. The Examiner has maintained the 35 USC 101 rejection as currently presented below in the Office Action. The Examiner has carefully explained the basis for the continued 35 USC 101 rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 23, 30, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: "*reproducing engine that reproduces*".

Independent claims 1, 9, 15, and 29 contain claim limitations that include a reproducing engine that reproduces the AV contents and multimedia element(s).

However, independent claims 23, 30, and 31 contain reproduced AV contents and multimedia element(s) but these independent claims do not comprise a reproducing engine that actually is responsible for reproducing AV contents and multimedia element(s).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1, 9, 15, 23, 29, 30, and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Independent claims 1, 9, 15, 23, 29, 30, and 31 recite "AV contents" and "application program interface (API)".

As defined in the specification of the applicants' published document, Publication No. 20040255235, at ¶0049, AV content is a programming language such as Java script. At ¶0010, 0017, and 0029 of Publication No. 20040255235, API is an application program interface. Both claim limitations for AV content and application program interface are simply a software program. Neither of these software program elements are comprised within hardware, wherein the hardware actually implements and executes the software program of AV contents and application program interface.

The Examiner kindly directs the applicants' attention to the statutory requirements of the MPEP 2106.01:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

The above cited paragraph from the MPEP 2106.01 clearly states that a software claim is non-statutory subject matter. In the applicants remarks received on May 22, 2007 the applicants have stated that Beauregard claims 29 and 30 were sufficient enough to overcome the proposed 35 USC 101 rejection. However, the applicants'

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assertion in presenting claims 29 and 30 are not enough to overcome the 35 USC 101 rejection.

The Examiner kindly requests that the applicants consider the following proposed amendment to independent claims 1, 9, 15, 23, 29, 30, and 31. The proposed amendment is as follows:

a computer apparatus comprising:

a storage device comprising an application programming interface and an audio visual (AV) contents; and

a processor configured to execute the application programming interface and audio visual (AV) contents;

Therefore, the remaining claims are dependent claims, these claims are also rejected for being dependent upon the above rejected independent claims.

NAME OF CONTACT

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Lewis/
Patent Examiner, A.U. 2167
July 31, 2007